IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Chris Mesa et al. **ATTORNEY DOCKET NO**: 10017722-1

SERIAL NO.: 09/944,659 **GROUP ART UNIT:** 2174

FILED: August 31, 2001 **EXAMINER:** T. Chuong

TITLE: Scanning To At Least One Of Multiple Destinations

APPEAL BRIEF (FOR THE THIRD APPEAL)

This Appeal Brief (For The Third Appeal) accompanies a Notice of Appeal filed in response to the Office Action mailed February 15, 2007. In response to the appeal brief filed in the prior (second) appeal, the Examiner advances new grounds for rejection. The Applicants have elected to initiate a new appeal to address the new grounds, rather than reply to the latest Office Action under Rule 1.111.

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 23-31 are pending. Claims 1-22 have been canceled. The rejection of all Claims 25-27 and 30-31 is appealed. The rejection of Claims 23-24 and 28-29 is not appealed.

4. STATUS OF AMENDMENTS.

All amendments have been entered. No amendments were filed after the most recent final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

The following "concise explanation" of the subject matter recited in each of the independent claims is provided solely because it is required as a "summary" by 37 C.F.R. § 41.37(c)(1)(5). This explanation/summary is not intended to nor does it define the claimed subject matter and, therefore, it should not be used to interpret the claims or to limit or narrow the scope of the claims.

Concisely explained, Claims 23 and 28 are directed to a method and computer instructions, respectively, through which an input peripheral scans a document in response to the destination device requesting that the input peripheral begin transmitting data.

Concisely explained, Claims 27 and 31 are directed to a method and computer instructions, respectively, through which an input peripheral scans a document in response to the destination device acknowledging a notification from the input peripheral. In addition, these claims involve a two-tiered destination selection scheme -- displaying a user interface from which multiple destination devices and a resource on the destination device(s) may be selected to receive data from the input peripheral.

Claim 23 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability (Fig. 1, display 114; Fig. 2, step 210; and Specification, page 9, lines 21-23 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device has been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Fig. 2, steps 216, 218 and 220 and Specification, page 11, lines 17-20).

Claim 27 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Fig. 2, step 210 and Specification, page 10, lines 8-21 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Fig. 2, steps 216, 218 and 220; Fig. 3, steps 318 and 320; and Specification, page 11, lines 17-20 and page 12, lines 4-5).

Claims 28 and 31 are computer medium counterparts to method Claims 23 and 27, respectively, and recite similar limitations. Hence, the supporting citations to the Specification are the same.

6. GROUNDS FOR REJECTION TO BE REVIEWED.

A. Claims 25-27 and 30-31 stand rejected under Section 102(b) as being anticipated by Monty (5799070).

B. The Specification was objected to under Rule 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter.

7. ARGUMENT.

A. Claims 25-27 and 30-31 stand rejected under Section 102(b) as being anticipated by Monty.

Claims 25-27 and 30-31 have been rejected under Section 102(a) as being anticipated by Monty (5799070).

Claims 25 and 27 recite a two tiered destination selection scheme -- (1) displaying a user interface from which one or more of multiple destination devices and a resource on one or more of the devices may be selected to receive data from an input peripheral and (2) the input peripheral transmitting data representing the document to the resource on the selected destination device(s). Claims 30 and 31, as computer medium counterparts to method Claims 25 and 27, contain similar limitations.

The Examiner asserts the fax number of the destination device in Monty is the claimed resource. This assertion is not correct. Monty teaches only the selection of a destination device represented by its fax number, not a resource on the destination device.

The Examiner's analysis of Claim 25 on page 5 of the Office Action is set forth below in full.

> As to claim 25, Monty shows the method further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting date representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (a resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1).

The cited passage in Monty teaches a conventional faxing sequence in which the user enters (or selects) the number of the destination device on the sending device, the sending device dials the number, the two devices shake hands, and then the sending device scans and transmits the document to the destination device. There is nothing in Monty that suggests the fax number of the destination device is a resource on the destination device, as opposed to the destination device itself.

The following example from page 10 of the Specification may help illustrate the distinction.

> "The display may, for example, show more specific listings such as:
>
> Anne's PC:Email
>
> Anne's PC:AppName
>
> Bill's PC:Fax
>
> Bill's PC:FileName
>
> Fred's NT Machine:AppName
>
> In these examples, the text prior the [sic] colon (":") indicates the primary target (i.e., the host). The text following the colon indicates the secondary target (e.g., the name of the application to receive the data, the name of the file to store the data, etc.). Alternatively, the options may be displayed in the step-through type hierarchy. In such a scenario, after the user selects a primary target, a list of 20 secondary targets associated with that primary target is displayed. The user may select the secondary target from that list."

In this example, the user interface display allows the user to select the destination device (e.g., Anne's PC) and a resource on the destination device (the email or an application on Anne's PC). Monty does not teach any such two-tiered destination selection scheme. The Examiner has, therefore, failed to establish a prima facie case of anticipation.

The rejection of Claims 25-27 and 30-31 should be reversed.

B. The Specification was objected to under Rule 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter.

The Examiner's remarks supporting the objection to the Specification under Rule 1.75(d)(1) are quoted below in full.

> The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(l) and MPEP § 608.01(0). Correction of the following is required: a computer readable medium as claimed in claims 28 and 31 is not specifically defined what exactly the computer readable medium is from a list of hardware and devices listed in the specification (pages 18-19). The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrase used in the claims must find clear support or antecedent basis in the description so that the meaning of

the terms in the claims may be ascertainable by reference to the description.

A computer readable medium claim has been present in this application since it was filed, yet the Examiner has waited until the fifth action on the merits to raise this objection. The lengthy delay itself casts doubt on the propriety of the objection. In any event and as detailed below, the objection is without merit and should be withdrawn.

Rule 1.75(d) requires that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." So far as Applicants are aware, however, Rule 1.75(d) does require that a computer readable medium be "specifically defined ... from a list of hardware and devices...." Certainly, the Examiner has not cited any authority in support of this requirement. The objection should be withdrawn for this reason alone.

There is nothing inherently ambiguous or vague about the term "computer readable medium." Indeed, it is a well known term used frequently in patents to denote any of numerous types of computer programming media. The Specification discloses specific examples of computer readable media that may be used to implement exemplary embodiments. Fig. 4 and the accompanying description beginning on page 18, line 15, in the Specification shows "an exemplary computing device 400 that may be utilized to implement a portion of the exemplary kick-pull scan destination director." Computing device 400 includes "memory 408 (such as ROM and/or RAM), a disk drive 410, a floppy disk drive 412, and a CD-ROM drive 414." ROM, RAM, hard disks, floppy disks and CD-ROMs are all well known forms of computer readable media. The Specification also states, for example, that Figs. 2 and 3 show "methodological implementations" that "may be performed in software, hardware, or a combination thereof." Specification page 11, line 6. Thus, the computing device in MFP 110 displaying a user interface listing the primary and secondary targets in step 210 of Fig. 2, for example, may use computer readable instructions on one or more of a memory 408, disk drive 410, floppy disk drive 412 or CD-ROM drive 414 from exemplary computing device 400 in Fig. 4 to perform this step.

Applicants respectfully submit that an ordinarily skilled artisan could readily ascertain the meaning of a "computer readable medium" by reference to the description.

Respectfully submitted,

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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

23.(not appealed) A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device; and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

24.(not appealed) The method of Claim 23, wherein the input peripheral comprises a scanner or a multifunction peripheral.

25. The method of Claim 23, further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

26. The method of Claim 25, wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data, an email address to send the data, or a storage location to store the data.

27. A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

28.(not appealed) A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device;

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

29.(not appealed) The medium of Claim 28, wherein the input peripheral comprises a scanner or a multifunction peripheral.

30. The medium of Claim 28, further comprising instructions for displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the instructions for the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprise instructions for the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

31. A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

APPENDIX III -- RELATED PROCEEDINGS

none